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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,447	07/25/2006	Menno Willem Jose Prins	NL040059US1	1231
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SAN JOSE, CA 95131				
EXAMINER				
VARGAS, DIXOMARA				
ART UNIT		PAPER NUMBER		
2859				
MAIL DATE		DELIVERY MODE		
02/13/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/587,447

Applicant(s)

PRINS, MENNO WILLEM JOSE

Examiner

DIXOMARA VARGAS

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-18 and 20-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3-17 and 27 is/are allowed.
- 6) ☒ Claim(s) 18-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date ____.

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 18-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claimed invention is directed to a judicial exception to 35 U.S.C. 101 (i.e., an abstract idea) and is not directed to a practical application of such judicial exception (e.g., because the claim does not require any physical transformation and the invention as claimed does not produce a useful, concrete, and tangible result). The language in the claim suggests only a combination of instructions and lacks a tangible result at the end of the procedure.

Allowable Subject Matter

3. Claims 1, 3-17 and 27 are allowed.
4. The following is an examiner's statement of reasons for allowance:
 - a. With respect to claim 1, the claim has been found allowable over the prior art of record because the prior art of record fails to teach or fairly suggest a device for on-chip magnetic resonance measurements for use with a first orienting magnetic field, the device comprising a magnetic sensor being a magneto-resistance sensor in combination with the remaining limitations of the claim.

- b. With respect to claims 3-17 and 27, the claims have been found allowable due to its dependency on claim 1 above.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

5. Claims 18 and 20-26 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 101, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter:

- c. With respect to claim 18, the claim has been found allowable over the prior art of record because the prior art of record fails to teach or fairly suggest a method for performing on-chip magnetic resonance measurements, the method comprising: the step wherein on-chip detecting of spin magnetic moments precession is performed by a magneto-resistance sensor in combination with the remaining limitations of the claim.

- d. With respect to claims 20-26, the claims have been found allowable due to its dependency on claim 18 above.

Response to Arguments

7. Applicant's arguments filed 01/07/08 have been fully considered but they are not persuasive.

8. Applicant argues that the 35 U.S.C. 101 rejection is improper in view of the interpretation of the Official Gazette stating that the claimed invention falls within section 101 Judicial Exception only if the claim language is regarding a law of nature, natural phenomena or abstract idea. However, the examiner failed to state if the claim language is regarding a law of nature, natural phenomena or abstract idea in order to apply the section 101 Judicial Exception.

9. The examiner disagrees with applicant's argument because in order to determine if the claim language of the application falls within section 101, the examiner needs to determine first if the claim language falls into the category of a Judicial Exception or practical application within the judicial exception. After said reasoning is performed and the examiner determines that the application falls into the category of a Judicial Exception like on the current application as discussed above, the examiner needs to determine if said Judicial exception is caused by an abstract idea, law of nature or natural phenomena. Once it is being determined that the Judicial Exception is caused by an abstract idea, as in the current application as stated above in the Office Action, it is determined if the abstract idea is caused by the lack of useful, concrete and tangible result at the end of the procedure or physical transformation. As stated above in the current Office Action and in the previous Office action dated 09/21/07, the claims 18-26 are directed to an abstract idea under the Judicial Exception since the claim language lacks a concrete and tangible result at the end of the procedure. See MPEP Alappat, 33 F.3d at 1542, 31 USPQ2d at 1556. The claimed language lacks a tangible result since the claim language of the method in the current application only requires a method for performing a measurement wherein after performing the excitation; a detection of the spins is

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performed. However, the steps of measuring and detecting do not constitute a tangible result and the claim language fails to point out if there is an output data caused by the detection of said spins. The detection step is a detection of a signal through a detecting means where said detected signal does not constitute a tangible result. However, if said received or detected signal is reconstructed in order to create an output data available to the user, for example, in a form of a graph, image, table or data values, said output is considered to be a tangible result since said signal after being detected, an output has being created and made available to the user in a tangible manner. For the reasons stated above, the 35 U.S.C. 101 stands and considered proper.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DIXOMARA VARGAS whose telephone number is

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(571)272-2252. The examiner can normally be reached on Monday to Thursday from 8:00 am. to 4:30 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean A. Reichard can be reached on (571) 272-1984. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brij B Shrivastav/
Primary Examiner, Art Unit 2859

Dixomara Vargas
Patent Examiner
Art Unit 2859